REMARKS

Counsel for the applicants wishes to thank the examiner for the courtesy of the telephone interview on August 23, 2007. The following includes the required discussion of the substance of the interview.

Claims 1-3, 6-9, and 11-25 are pending. Claims 4-5 and 10 have been canceled. Claims 24-25 are added. The applicants respectfully request reconsideration and allowance of this application in view of the above amendments and the following remarks.

Claims 1, 12-15, 18 and 19-23 were rejected under 35 USC 101 as being directed to non-statutory subject matter. Claims 1, 12-15 and 19-23 were rejected as not reciting a tangible result "since there is no output." Claim 1 has been amended to specifically recite "outputting prices of the electronic entity events;" claims 12-15 and 19-23 have been similarly amended. Therefore, the examiner is respectfully requested to reconsider and withdraw the rejection.

Claim 18 was rejected under 35 USC 101 as not reciting any specific computer readable medium. Claim 18 as now amended is in Beauregard claim format. It is respectfully requested that the examiner reconsider and withdraw the rejection.

Claims 1, 12-15, 18 and 19 were rejected under 35 USC 112, second paragraph, as being indefinite. Each of the instances of indefiniteness listed in the office action is remedied by way of the above amendment. Specifically, claim 1 has been amended to recite "dynamically and automatically, by a computer, pricing a servicing of the electronic entity events ...;" claims 12-15, 18 and 19 are amended similarly. In claims 1, 12-16, 18 and 19, the phrase "can be" and "can specify" have been amended to "are" and "specifies," respectively.

Claims 1, 12-16, 18 and 19 were rejected under 35 USC 112, second paragraph with regard to the limitation "pricing servicing of the events," in which apparently "the events" is

14

Serial No. 09/741,908   Attorney Docket No. 69.001

unclear. Claims 1 and 19 have been amended to read "pricing a servicing of the electronic entity

events." Insofar as the rejection can be understood to apply to claims 12-16 (which do not

include this limitation), these claims have been similarly reviewed and revised if appropriate. In

claims 1, 12-16, 18 and 19, the phrase "shared among plural pricing plans" has been amended to

"shared among the plural different pricing plans." In claim 22, the phrase "the at least one rule

can specify" has been amended to read "the at least one rule specifies."

The examiner's rejection under 35 USC 112, second paragraph of claims 1, 12-16, and

18-20 for lacking an antecedent basis is respectfully traversed. When a claim "is not insolubly

ambiguous, it is not invalid for indefiniteness." *Marley Mouldings, Ltd. V. Mikron Industries*,

417 F.3d 1356, 1361 (Fed. Cir. 1005). The failure to provide a missing antecedent clause does

not render the claim(s) indefinite. E.g., *Slimfold Mfg. Co. v. Kinkead Indus., Inc.*, 810 F.2d 1113,

1117 (Fed. Cir. 1987); *Energizer Holdings, Inc. v. International Trade Commission*, Fed. Cir. No.

05-1018 (Fed. Cir. 1/25/2006). Accordingly, the rejection of these claims as lacking antecedent

basis should instead have been made as an objection.

In order to address the objection which should have been made instead of the rejection, in

claims 1, 12-16, 18 and 19, the antecedent basis for "wherein the rules can be shared" has been

corrected. In claims 1, 12-16, 18 and 19, the phrase "the outcome" has been amended to read

"an outcome." In claim 20, "the accumulated exchange transactions over a time period" has

been amended to read "the exchange transactions accumulated over a time period." Accordingly

claims 1, 12-16, and 18-20 have been amended as to matters of form only to address the

Examiner's concerns relating to clarity and not for reasons related to patentability. Thus the

scope of claims 1, 12-16, and 18-20 has not been narrowed within the meaning defined in *Festo*

Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., 535 U.S. 722 (2002).

15

For all of the above reasons, the examiner is respectfully requested to reconsider and withdraw the rejection under 35 USC 112, second paragraph of claims 1, 12-16, 18-20 and 22.

Claims 1-3, 5-13 and 16-23 were rejected under 35 USC 103(a) as being obvious over U.S. Patent No. 5,852,812, Reeder et al. ("Reeder") in view of U.S. Patent Pub. No. 2001/0034693, Farhat et al. ("Farhat"). Claim 14 was rejected under 35 USC 103(a) as being obvious over Reeder and Farhat, further in view of U.S. Patent No. 6,754,636, Walker et al. ("Walker"). Claim 15 was rejected under 35 USC 103(a) as being unpatentable over Reeder in view of U.S. Patent Pub. No. 2001/0018672, Petters et al. ("Petters") further in view of Farhat. Insofar as the rejections can be applied to the claims as amended, the rejections are respectfully traversed for reasons including the following, which are provided by way of example.

To properly reject a claimed invention, the examiner must establish a *prima* facie case of obviousness. To establish a *prima facie* case of obviousness with respect to a claimed invention, all the claim limitations must be taught or suggested by the reference (or references when combined). *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Moreover, it is necessary to identify the reason why a person of ordinary skill in the art would have combined allegedly known elements in the manner claimed. *KSR Int'l Co. v. Teleflex, Inc.* No. 04-1350 (U.S. Apr. 30, 2007). The examiner bears the burden of establishing this *prima facie* case. *In re Deuel*, 34 U.S.P.Q.2d 1210, 1214 (Fed. Cir. 1995). Where, as here, the examiner fails to establish a *prima facie* case of obviousness, the applicant is entitled to grant of patent. *In re Oetiker*, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992).

Independent claims 1, 12, 13, 14, 15, 16, 18, and 19 have been amended with regard to the rejection under 35 USC 103(a) to recite that the decision network is a tree structure. Support

16

for the amendment is located in the application as filed, for example, FIG. 6, FIG. 19, FIG. 33, and FIG. 46, and accompanying description of the tree structure.

Claim 1 recites, in combination, that "each pricing plan includes a decision network, wherein the decision network is a tree, wherein a node of the decision network includes at least one rule, where rules including the at least one rule are shared among the plural different pricing plans, where a path along the tree from the node for an exchange transaction is determined from an outcome of the at least one rule using the exchange transaction corresponding to the electronic entity event as input." (See also independent claims 12, 13, 14, 15, 16, 18 and 19.)

The nodes of the tree include the rules, and the path through the tree is defined by the outcome of the rules. Therefore someone with no knowledge of programming simply can specify and/or rearrange the nodes or the rules used in parts of the tree without re-coding the rules or a non-tree-form decision network.

On the other hand, without conceding that Reeder discloses any feature of the present invention, Reeder is directed to a billing system for an online computer network (abstract). Farhat is directed to a method of brokering a service access transaction (abstract).

The applicants provide herein a selection of some examples of limitations in the claims which are neither taught nor suggested by Reeder. The Office Action admits that Reeder does not disclose that the rules are stored in a database, but states that "Reeder discloses that the pricing rules are written in pseudo-code and used to determine a charge for a particular transaction event and that the pricing rules are 'looked up'." (Office Action, pages 7-8, quoting Col. 15, line 34 to Col. 16, line 17.) The Office Action also admits that Reeder fails to teach or suggest that the rules specify use of the collection to determine the outcome of the rule. Recognizing that Reeder fails to teach and/or suggest the invention as claimed, the examiner

17

relies on Reeder's use of rules written in in-line pseudo-code and cites Farhat to as teaching use of a collection to determine the outcome of the rule.

Nevertheless, Farhat fails to remedy such deficiencies with respect to the amended claims. For example, Reeder fails to teach or suggest that the decision network is a tree, wherein a node of the decision network includes at least one rule, where the rules are shared among the plural different pricing plans, and wherein the rules are stored in a database. The examiner cites Reeder's pseudo-code which looks-up rules as an example of a decision network which includes rules specifically as nodes. It is clear that the pseudo-code is not a tree. Furthermore, the pseudo-code fails to teach or suggest a tree.

In addition, even if the pseudo-code is considered to be a tree (which applicants vigorously deny), then it is completely clear that a path from the "node" in the pseudo-code including the rule is not determined from an outcome of the rule. This is particularly clear since the examiner admits that Reeder does not use the collection to determine an outcome of the rule. To the contrary, according to Reeder's pseudo-code, the same processing path occurs without regard to the outcome of the rule.

The remaining references of record fail to remedy the deficiencies of the cited references.

Hence, Reeder and Farhat, alone or in combination with each other or other references, fail to teach or suggest the combination of features recited in independent claims 1, 12, 13, 14, 15, 16, 18, and 19, when considered as a whole.

With respect to the rejected dependent claims, the applicants respectfully submit that these claims are allowable not only by virtue of their dependency from independent claims 1, 12, 13, 14, 15, 16, 18, and 19, but also because of additional features they recite in combination.

18

Serial No. 09/741,908   Attorney Docket No. 69.001

Dependent claims 24 and 25 are added. Support for new claim 24 is located in the application as filed, for example, FIG. 6, FIG. 19, and page 13 (paragraph [0042]). Support for new claim 25 is located in the application as filed, for example, page 6, line 35 to page 7, line 13; and FIG. 1 element 20.

Original claim 11 is amended to remedy cosmetic defects. Support for the amendment is located in the application as filed, for example, page 8, lines 9-20.

The applicants respectfully submit that, as described above, the cited prior art does not show or suggest the combination of features recited in the claims. The applicants do not concede that the cited prior art shows any of the elements recited in the claims. However, the applicants have provided specific examples of elements in the claims that are clearly not present in the cited prior art.

The applicants strongly emphasize that one reviewing the prosecution history should not interpret any of the examples applicants have described herein in connection with distinguishing over the prior art as limiting to those specific features in isolation. Rather, for the sake of simplicity, applicants have provided examples of why the claims described above are distinguishable over the cited prior art.
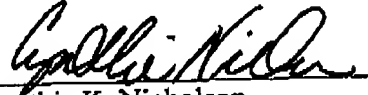
In view of the foregoing, the applicants submit that this application is in condition for allowance. A timely notice to that effect is respectfully requested. If questions relating to patentability remain, the examiner is invited to contact the undersigned by telephone.

19

Serial No. 09/741,908   Attorney Docket No. 69.001

If there are any problems with the payment of fees, please charge any underpayments and

credit any overpayments to Deposit Account No. 50-1147.

Respectfully submitted,

Cynthia K. Nicholson
Reg. No. 36,880

Posz Law Group, PLC
12040 South Lakes Drive, Suite 101
Reston, VA 20191
Phone 703-707-9110
Fax 703-707-9112
Customer No. 23400

20